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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,455	10/03/2001	Michael H. Benjamin	FCC-001	9639
34051	7590	06/14/2007		
STEVENS LAW GROUP P.O. BOX 1667 SAN JOSE, CA 95109			EXAMINER STERRETT, JONATHAN G	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/970,455

**Applicant(s)**

BENJAMIN ET AL.

**Examiner**

Jonathan G. Sterrett

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 9, 19, 21-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 9, 19, 21-23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Summary*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 March 2007 has been entered.

2. Currently **Claims 1, 6, 9, 19, 21-23, 25 and 26** are pending in the application.

### *Response to Amendments*

3. The previous 112 2<sup>nd</sup> rejections are withdrawn; however, please see the new 112 2<sup>nd</sup> rejections below. The 35 USC 101 rejections for tangibility and usefulness are withdrawn, however, please see the 35 USC 101 rejections below for concreteness.

### *Response to Arguments*

4. The 35 USC 103(a) rejections are withdrawn.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 1, 6, 9, 19, 21-23, 25 and 26** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. Regarding independent **Claims 1, 19 and 23**, the claims cite defining a performance vector that includes a set of performance metrics. The specification does not set forth how these performance metrics are to be determined. The specification states that these performance metrics are based upon evaluating a supplier's performance on a job with respect to rating performance categories 0-5 depending on how the user defined those categories. For example on page 15 para 37, the supplier is rated 0-5 according to those categories according to unacceptable, poor, below average, average, good and perfect, respectively. There is nothing more than these descriptions in defining for a user to determine how a supplier is to be evaluated. Thus the specification does not set forth how one of ordinary skill in the art would define these ratings as an input to the steps of assessing a supplier.

**Claims 6, 9, 21, 22, 25 and 26** depend on **Claims 1, 19 and 23** and are therefore non-statutory under 35 USC 112 1st for at least the reasons cited above for **Claims 1, 19 and 23**.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 23, 25 and 26** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claim 23**, the set of interface modules as claimed are merely adapted to perform the various cited functions in assessing a supplier; however the system does not actually recite that these limitations are performed. For the purposes of examination, the examiner assumes the applicant will amend the claim to recite that the interface modules actually perform the cited functions.

**Claims 25 and 26** depend on **Claim 23** and are therefore indefinite at least for the reasons cited above for **Claim 23**.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 6, 9, 19, 21-23, 25 and 26** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77). Additionally, a claim may not preempt abstract ideas, laws of nature or natural phenomena nor may a claim preempt every “substantial practical application” of an abstract idea, law of nature or natural phenomena because it would in practical effect be a patent on the judicial exceptions themselves (*Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972)). (Please refer to the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” for further explanation of the statutory requirement of 35 U.S.C. § 101.)

Regarding independent **Claims 1, 19 and 23**, the claims cite defining a

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performance vector that includes a set of performance metrics. This input to the claim would be substantially different, depending on the individual that is defining these performance metrics. The specification states that these performance metrics are based upon evaluating a supplier's performance on a job with respect to rating performance categories 0-5 depending on how the user defined those categories. For example on page 15 para 37, the supplier is rated 0-5 according to those categories according to unacceptable, poor, below average, average, good and perfect, respectively. There is nothing more than these descriptions for a user to determine how a supplier is to be evaluated. Thus the ratings depend on the interpretation of the user rather than what is specified.

Therefore, one individual using the claimed invention could realize a substantially different outcome than another individual (the specification does not provide guidelines, e.g. tables, to enable a practitioner to know, for example, how a performance rating of average is defined and would be applied to the supplier). Because the claims may be used as such to provide different outcomes, the invention as claimed does not provide for a result that is substantially repeatable, and therefore does not provide a **concrete** result.

Because **Claims 1, 19 and 23** do not provide for a concrete result, these claims are rejected under 35 USC 101.

**Claims 6, 9, 21, 22, 25 and 26** depend on **Claims 1, 19 and 23** and are therefore non-statutory under 35 USC 101 for at least the reasons cited above for **Claims 1, 19 and 23**.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Banfield, Emiko; "Harnessing Value in the Supply Chain", ©1999, John Wiley & Sons, pp.189-205, 224-227, 233-235, 253-269, 281-285.

Grittner, Peter; "FOUR ELEMENTS OF Successful Sourcing Strategies (Commitment and coordination, with a view towards cost analysis, are needed with partners who supply goods and services)", October 1996, Management Review, v 85, n 10, p 41-45, Dialog 00511587 23656161.

Aberdeen Group, "Strategic Sourcing: Key to Competitiveness in the Internet Economy", Sept 2000, Aberdeen Group, Inc., Boston, pp.1-18.

Mohamed A. Youssef; Mohammed Zairi; Bidhu Mohanty; "Supplier selection in an advanced manufacturing technology environment: an optimization model", 1996, Benchmarking for Quality Management & Technology v3n4 PP: 60, Dialog 02243566 84986974.




Smytka, Daniel; Clemens, Michael; "Total Cost Supplier Selection Model: A Case Study", Winter 1993, 39, 1; ABI/INFORM Global, pp.42-49.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 6-8-2007

  
JONATHAN G. STERRETT  
AU 3623 EXAMINER